

REMARKS / ARGUMENTS

Claims 1-2, 4-21 and 25-49 are pending in the instant application, of which claims 3 and 22-24 have been previously cancelled, and claims 1-2, 4-17, 26-32 and 42-49 are withdrawn. Claims 18, 33, 36 and 39 are independent. Claims 19-21, 25, 34-35, 37-38 and 40-41 depend directly or indirectly from independent claims 18, 33, 36 and 39, respectively.

The Examiner has restricted the claims into group I (claims 1, 2, 4-17, 42-45, 26-32 and 46-49), and group II (claims 18-21, 25 and 33-41). The Examiner further alleges that group I claims and group II claims are different and distinct species, thus requiring an election/restriction under 35 U.S.C. 121.

In order to advance prosecution, the Applicant has elected group II (claims 18-21, 25 and 33-41) with traverse. The claims of group I have been withdrawn. The Applicant respectfully traverses that group I claims 1, 2, 4-17, 42-45, 26-32 and 46-49 and group II claims 18-21, 25 and 33-41 are patentably distinct under 35 U.S.C. 121 requirements in view of the following arguments and remarks.

FACTS

The Examiner, in page 2 of the Office Action, states the following:

1. This application contains claims directed to the following patentability distinct species

I) Claims 1, 2, 4-17, 42-45, 26-32 and 46-49 are allegedly drawn to a system/method comprising a plurality of servers, each comprising by a distinct integrated convergent network controller chip.

II) Claims 18-21, 25, 33-41 are drawn to a system/method comprising a plurality of servers, comprising a single integrated convergent network controller chip.

2. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record. For instance, **it would not be obvious to modify from a single integrated convergent network controller chip (for processing a plurality of traffics) of species II to separate integrated convergent network controller chips for the plurality of servers of species I.**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species **require a different field of search** (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The Examiner, in effect, argues that the single integrated convergent network controller chip of claim 18 (i.e., the group II species) has a distinct and mutually exclusive characteristic from the single integrated convergent network controller chips in the respective servers of claim 1 (i.e., the group I species), thus requiring a different field of search. The Applicant respectfully disagrees as the convergent network controller chips, as used in claims 1 and 18, have substantially similar functionalities, as further illustrated below.

TRAVERSAL

The restriction requirement is respectfully traversed because “if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct invention.” Manual of Patent Examining Procedure (MPEP) § 803. Thus, **even if the inventions are independent or distinct, restriction is improper if the search and examination of all the claims can be made without serious burden.**

One of the “two criteria for a proper requirement for restriction between patentably distinct inventions” is that “[t]here must be a serious burden on the examiner if restriction is not required...” See *id.* (emphasis added). While “[f]or purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 803.02.” See *id.* The Examiner has not shown, however, an explanation of separate classification, separate status in the art, or a different field of search, as is required to demonstrate a *prima facie* serious burden.

The Applicant points out that the single integrated convergent network controller chip in both claim 1 (i.e., the alleged group I species) and claim 18 (i.e., the alleged group II species), disclose the **identical functionality** of “**concurrently process the**

plurality of different types of network traffic” for each of the claimed servers. More specifically, the Examiner is referred to the claim 1 which recites:

“...**process** respectively via the **first single integrated convergent network controller chip**, the **second single integrated convergent network controller chip** and the **third single integrated convergent network controller chip**, a plurality of different traffic types concurrently...”

The Examiner is referred to the claim 18 which recites:

“...the **single integrated convergent network controller chip** is operable to concurrently process the plurality of different types of network traffic, for the plurality of servers...”.

Since the **single integrated convergent network controller chip** in both claims 1 and 18 perform identical functionality, the Applicant maintains that the **single integrated convergent network controller chip** in group I and group II are neither patentably distinct, nor mutually exclusive species. Therefore, the Applicant submits that **claims 1, 2, 4-17, 42-45, 26-32 and 46-49 in group I and claims 18-21, 25, 33-41 in group II, both belong to the same class in the field of search.**

Accordingly, the Applicant respectfully submits that the search and examination of all of the pending claims can be made without serious burden to the Examiner. Thus, the Applicant respectfully requests that the present restriction requirement under 35 U.S.C. 121 be reconsidered and withdrawn. The Applicant reserves the right to petition to the Director under 37 C.F.R. §1.144 to review the restriction requirement in the present application.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all pending claims 1-2, 4-21 and 25-49 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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